REMARKS

In the June 2, 2008 Office Action, the Examiner noted that claims 1-32 were pending in the Application. Claims 1, 19-21, 30 and 32 have been amended herein. New claims 33 and 34 have been added herein. Thus, claims 1-34 are pending for consideration, which is respectfully requested. No new matter has been added.

Applicants have submitted herewith a CD having stored thereon "StraussController.exe" as Exhibit A and "StraussDrag.mov" as Exhibit B. Exhibit A is an executable applet simulating an example of a "menu boundary... coincident with the outer edge [and] a tracking symbol tracking a position of a position transducer moved by a user... initiating movement of the interface to track the tracking symbol when the boundary is encountered" as recited in claim 1. Exhibit B is a movie comparing the functionality of Strauss with an example of the tracking according to claim 1.

Rejection under 35 U.S.C. 101

On page 2, item 6 of the Office action, claims 1-21 and 32 were rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter.

Applicants submit that claims 1, 19-21 and 31 are not directed to software *per se*. For example, claim 1 has been amended for clarification purposes to recite "A graphical user interface displayed on a display," and therefore, is directed to statutory subject matter. Claims 19-21 and 32 have been amended herein in a similar manner.

In view of the above, Applicants request the rejection be withdrawn.

Rejections under 35 U.S.C. 103(a)

On page 3, item 8 of the Office action, claims 1-4, 7, 9-12, 14-18 and 20-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Selker (U.S. 6549219) in view of Iwema et al. (U.S. 7058902) further in view of Strauss (U.S. 6,246,411). This rejection is respectfully traversed.

On page 5, second paragraph, the Office Action concedes that Strauss fails to teach that the tracking menu boundary is coincident with the outer edge. The Office Action, however, states:

> it would have been obvious to one of ordinary skill in the art at the time the
> invention was made to have implemented this limitation because Strauss
> suggests to the skilled artisan that different designs can be applied for the drag
> toolbar such as the drag toolbar can be in different shapes with different controls

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(e.g., see Figs. 2A-4B; col. 4, lines 24-54). One would be motivated to implement this feature is to provide a user with a visual cue or feature as to what the tracking boundary is so that the user may use the tracking menu more efficiently (sic).

As shown above, the Office Action merely provides a conclusion without a rationale, and thus, Applicants respectfully traverse the Office Action's assertion for the reasons discussed below.

First, Applicants submit that the Examiner fails to establish that providing a visual cue for a tracking boundary is obvious. The Examiner merely states that Strauss describes "different designs can be applied for the drag toolbar such as the drag toolbar can be in different shapes with different controls." Merely describing a toolbar with different shapes or controls, however, does not teach or suggest implementing a visual cue (e.g. drawn border) defining a tracking boundary. The Office Action states that one would be motivated to employ such a feature in order to use the tracking menu more efficiently. Applicants respectfully submit, however, that the Office Action's mere assertion of using a menu more efficiently without any teaching or suggestion from the prior art for the feature is based on impermissible hindsight. Applicants submit that a mere motivation to use a tracking menu more efficiently with nothing more does not render such a feature obvious. Alternatively, if the Office Action asserts that such a feature is common knowledge, the Office Action fails to support such an assertion. Applicants submit that these features are not of notorious character or capable of instant and unquestionable demonstration as being well-known (see MPEP § 2144.03(A)). No evidence is provided to support the Office Action's assertion, and thus, it appears that the rejection, at least in part, is based on personal knowledge. Thus, Applicants call upon the Examiner to support such an assertion with an affidavit, provide evidence, or withdraw the assertion.

Second, even assuming arguendo, that there is some teaching in Strauss of a visual cue for a tracking boundary, Applicants submit that such a boundary would not be **coincident** with the outer edge (e.g. "a second region control... having an outer edge... [and] a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge" as recited in claim 1, lines 3-7). As shown in Strauss Figure 7, the tracking boundary is outside of the menu boundary. Thus, Applicants submit that even assuming arguendo the Strauss teaches a visual cue for a tracking boundary, the boundary would cover an area beyond the outer edge (e.g. see "follow me" zone 42 of Figure 7, see also column 6, lines 59-67).

Third, Applicants submit that Strauss not only fails to teach or suggest "a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge," but teaches away from such a feature. For example, Strauss states "the Drag Toolbar may be floating and have a 'follow me' characteristic, where the Drag Toolbar moves so as to always be

within a certain distance from the cursor" (Abstract, lines 17-19). In other words, <u>Strauss</u> explicitly states that the Drag Toolbar is within a certain distance *from the cursor* and not that the cursor is *within* the Drag Toolbar – if the region boundary was coincident to the Drag Toolbar boundary (i.e. cursor confined to space within Drag Toolbar), no reference to distance would be necessary. Further, <u>Strauss</u> states that "the invention provides an unambiguous way for a user to change the drag functionality of a cursor during a drag operation" (Abstract, lines 19-21). In other words, in order to provide an unambiguous way for a user to change the drag functionality (i.e. when a drag action is already activated) a person of ordinary skill in the art would likely not have a boundary region coincident with the menu boundary as errors for changing the drag function are more likely to occur (e.g. as shown in Exhibit B, moving a cursor confined to the Drag Toolbar would constantly highlight/activate items in the toolbar when the cursor is moved, whereas if the boundary is beyond the Drag Toolbar, an item can be activated and then a cursor is moved beyond the toolbar to navigate). Thus, the constant highlighting/activating would likely produce errors in changing a drag function, and would thus, be "ambiguous" which is in contrast to the explicit disclosure of Strauss. Moreover, in contrast to claim 1, for example, <u>Strauss</u> deals exclusively with a drag function. Thus, a person of ordinary skill in the art would want to limit the constant highlighting/activating of menu items because a drag function usually involves a time constraint (i.e. limit the amount of time that a user must hold down the mouse button ("drag")).

In view of the reasons set forth above, Applicants submit that the feature of "a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge" as recited by claim 1 is not obvious. Therefore, claim 1 patentably distinguishes over the cited art.

On page 7, item 9 of the Office action, claims 5, 22-24 and 28-32 were rejected under 35 U.S.C. 103(a) a being unpatentable over <u>Selker</u> in view of <u>Iwema</u> further in view of <u>Strauss</u> and further in view of <u>Warnock et al</u> (Patent No. 5,634,064). On page 11, item 10 of the Office action, claims 25-27 were rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Selker</u> in view of <u>Iwema</u> further in view of <u>Strauss</u> and further in view of <u>Warnock</u> and further in view of <u>Mullet et al</u>. (U.S. 5,638,523). On page 12, item 11 of the Office Action, claims 6 and13 were rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Selker</u> in view of <u>Iwema</u> further in view of <u>Strauss</u> and further in view of <u>Aarnock</u> and further in view of <u>Schirmer</u> (U.S. 6369837) and further in view of <u>Beaton et al</u>. (U.S. 6037937). On page 13, item 12 of the Office Action, claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Selker</u> in view of <u>Iwema</u> further in view of <u>Strauss</u> and further in view of <u>Warnock</u> and further in view of <u>Schirmer</u> and further in view of <u>Beaton</u> and further in view of <u>Nicholas, III</u> (U.S. 6,865,719). On page 18,

item 13 of the Office Action, claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Selker in view of Iwema further in view of Strauss and further in view of Nicholas. These rejections are respectfully traversed.

Applicants submit that Warnock, Mullet, Aarnock, Beaton, Schirmer, and Nicholas fail to cure the deficiencies of Strauss and Iwema described above.

Accordingly, Applicants submit that above discussion will aid the Examiner in appreciating the patentable distinctions of independent claims 19-22 and 29-32. For example, claim 20 recites "a tracking symbol movable within the control and moving the control when **the exterior edge of the peripheral region is encountered**" (lines 5-6, emphasis added).

The remaining dependent claims inherit the patentable recitations of their respective base claims, and therefore, patentably distinguish over the cited art for the reasons discussed above in addition to the additional features recited therein.

New Claims

Applicants submit that new claims 33 and 34 patentably distinguish over the cited art. Claim 33 recites "a tracking menu boundary surrounding the first and second region controls and coincident with the outer edge," and therefore, patentably distinguish over the cited art.

Claim 34 inherits the patentable recitation of claim 1, and therefore, patentably distinguishes over the cited art. In addition, claim 34 recites the feature of "said initiating movement of the interface to track the tracking symbol occurs when the menu and controls are not visible," which the cited art does not describe. For example, the menu in Strauss only tracks the tracking symbol when the drag function is initiated (i.e. when the menu is activated/viewable, see column 8, 15-18 and column 6, lines 52-55). Accordingly, Applicants submit that claim 34 patentably distinguishes over the cited art on this additional basis.

In view of the above, Applicants submit that new claims 33 and 34 patentably distinguish over the cited art.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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